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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,335	11/19/2001	Richard L. Pellegrini	106679.01	8588

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OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, VA 22320

EXAMINER

BROWN, MICHAEL A

ART UNIT	PAPER NUMBER
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3764

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/988,335

Applicant(s)

PELLEGRINI ET AL.

Examiner

Michael Brown

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 1-23, 41-44, 46-49 and 51-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-40, 45, 50 and 58-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group IV in the reply filed on November 1, 2004 is acknowledged. The traversal is on the ground(s) that claims are never species and that species are always the specific embodiments. This is not found persuasive because the claims determine if there are different species in a case. Also the figures in the drawings show and the claims recite the different species as set forth in the restriction.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24-25, 34, 40, 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langley in view Loos.

Langley discloses in figures 1-5 a disposable eye patch comprising a sheet member 10 and a metallic layer that doesn't overlap a peripheral portion of the sheet (fig. 5). The metallic material is aluminum. However, Langley doesn't disclose the sheet member being sized and to fit entirely with a human eye socket in a lateral dimension of the eye socket and or in a vertical dimension of the eye socket. Loos teaches in figures

Art Unit: 3764

1-3 an eye protector that is sized to fit entire within the human eye socket in a lateral dimension (which is one dimension of the eye socket), of the eye socket (col. 2, lines 30-40). It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the eye patch disclosed by Langley could be sized to fit entirely with a human eye socket in a lateral dimension of the eye socket as taught by Loos to prevent the pad from being dislodged from the eye socket. Loos teaches two materials wherein one doesn't overlap the other.

Claims 26-33, 35-39, 45 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims above, and further in view of Krupnick, along with Rosenblatt.

Krupnick teaches in figures 1-3 an eye patch comprising a sheet 24 having an adhesive 30 applied over at least the peripheral edge of the sheet. The eye patches are in a strip. Rosenblatt teaches in col. 3, lines 40-42 using a dispenser to hold a plurality of eye patches. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the adhesive as taught by Krupnick could be substituted for what appears to be two adhesive strips disclosed by Langley because either adhesive could be used to hold the eye patch over the socket of the eye. The eye patches could be placed in a dispenser as taught by Rosenblatt in order to keep them clean before use. The sheet and the metallic layer could be made of the same thickness because the dimensions recited in the claims are not critical. The metallic material could be any type of metallic material because the type of metallic material used is not critical. The foam material could be any plastic foam because plastic foams

are biocompatible and don't cause any harm to sensitive tissue, such as tissue around the eye ball.

Response to Arguments

Applicant's arguments filed December 20, 2005 have been fully considered but they are not persuasive. Applicant argues that combining Langley with Loos, is improper because the Langley eye patch is already prevented from being disclosed because it is held in place by tape or a headband. However, Langley was used to set forth the environment of an eye patch. Loos was used as a modifier to make the eye patch so it fits inside of the eye socket. Whether the tape or the headband is used to hold the eye patch in place is moot. Applicant argues that it wouldn't have been obvious to one having ordinary skill in the art to size the Langley eye patch to fit within the human eye socket because it would be contrary to Langley's teaching. However, using the eye patch disclosed by Langley to cover a post-operative eye is one function that Langley is capable of performing. On the other hand, Langley is capable of protecting the eye from a laser, too. The test that is applied here is whether Langley is capable of performing the same function, not whether Langley is used to perform the same function. However, if the device disclosed by Langley is exposed to a laser, clearly the eye would be protected. Applicant argues that combination of Langley and Loos wouldn't be a laser resistant eye patch. However, any patch that covers the eye that isn't transparent is capable of protecting the eye from a laser. Also, Langley teaches that if any light passes through the pores gauze or other material can be placed behind the pores to prevent light from passing therethrough (col. 3, lines 31-36).

Applicant argues that it wouldn't have been obvious to protect a patient eye during treatment of an adjacent portion of the patient's face for at least the reason that only used of the Langley eye patch contemplated relative to any treatment is in the context of protecting the eye after (not during) treatment. However, cleaning a patient's face (is considered as a treatment for an invalid). One of ordinary skill in the art would recognize that the Langley eye patch could be worn while treatment is done to the patient's face. In other words, the word "treatment is so broad, it can include just about anything done to a patient's face (i. e., pulling of a hair bump on the face, the removing of a pimple from the face). Applicant argues that the limitations pertaining to the thickness of the device were not addressed in the previous office actions. However, as set forth in the previous office action, the specification of the present invention lacks a showing of criticality in the thickness ranges recited in the claims. Thus, no patentable weight has to be given to the thickness range dimensions recited in the claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brown whose telephone number is 571-272-4972. The examiner can normally be reached on 5:30 am-4:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gergory Huson can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Brown
February 22, 2006

A handwritten signature in black ink, appearing to read "Michael A. Brown". The signature is fluid and cursive, with the first name "Michael" being the most prominent part.

MICHAEL A. BROWN
PRIMARY EXAMINER